

30. (ONCE AMENDED) The system of claim 29, wherein the intensity of influence of said external terminal is determined as the frequency of shifting from the source or drain of a MOS semiconductor device to the gate thereof while tracing a path linking the external terminal and one or more terminals of each of the plurality of partial circuits.

42. (ONCE AMENDED) The apparatus of claim 41, wherein the intensity of influence of said external terminal is determined as the frequency of shifting from the source or drain of a MOS semiconductor device to the gate thereof while tracing a path linking the external terminal and one or more terminals of each of the plurality of partial circuits.

REMARKS

Claims 9-12, 14-24, 26-36, and 38-44 are pending in the Office Action and have been rejected. Claims 18, 30, and 42 have been amended to correct various informalities and typographical errors. No new matter is being presented, and approval and entry are respectfully requested.

Entry of Amendment Under 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response because:

(a) it is believed that the amendment of claims 18, 30, and 42 puts this application into condition for allowance;

(b) the amendments were not earlier presented because the Applicants believed in good faith that the cited prior art did not disclose the present invention as previously claimed;

(c) the amendments of claims 18, 30, and 42 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and

(d) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that “any amendment that would place the case either in condition for allowance or in better form for appeal may be entered.” Moreover, Section 714.13 sets forth that “the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.” The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Rejections Under 35 U.S.C. §§ 102 and 103

On pages 2-6 of the Office Action, the Examiner rejected claims 9-12, 14-24, 26-36, and 38-44 under 35 U.S.C. §102(b) as being anticipated by Filseth (U.S. Patent No. 5,473,546); or Yokomizo et al. (“A New Circuit Recognition and Reduction Method for Pattern Based Circuit Simulation,” IEEE Custom Integrated Cir. Conf., pp. 9.4/1-9.4/4); or Chakrabarti et al. (“An Improved Hierarchical Test Generation Technique for Combinational Circuits with Repetitive Sub-Circuits,” IEEE Proc. Test Symp., pp. 237-243).

On pages 6 and 7 of the Office Action, the Examiner rejected claims 9-12, 14-24, 26-36, and 38-44 under 35 U.S.C. §102(e) as being anticipated by Hachiya (U.S. Patent No. 6,031,979).

On pages 7-9 of the Office Action, the Examiner rejected claims 9-12, 14-24, 26-36, and 38-44 under 35 U.S.C. §103(a) as being unpatentable over Shinsha et al. (U.S. Patent No. 4,882,690); or Wang et al. (“Restructuring Binary Decision Diagrams Based on Functional Equivalence,” IEEE Design Automation, pp. 261-65); or Kuehlmann et al. (“Equivalence Checking Using Cuts and Heaps,” IEEE Proc. 1997 Design Auto. Conf., pp. 263-68).

Applicants respectfully traverse these rejections.

The Examiner has repeated his prior art rejections from the prior Office Action. Applicants maintain their arguments as set forth in the previous responses.

In the telephonic interview of November 19, 2002, the applicants requested that the rejections be more specific, as indicated on page 10 of the Office Action. The applicants pointed out in the interview that large portions of the references had been quoted in the office actions, without pointing out where the features of the claims are disclosed in the references.

Section 2106 on page 2100-8 of the Manual of Patent Examining Procedure states the following: "Office personnel are to correlate **each claim limitation** to all portions of the disclosure that describe the claim limitation ... The correlation step will ensure that Office personnel correctly interpret each claim limitation" (emphasis added).

Also, in item 18 on page 13 of the Office Action, the Examiner indicated that the applicants have argued against the Shinsha, Wang, and Kuehlmann references individually without addressing the combination of these references when the rejection is based on a combination of references. However, the rejection in item 10 on page 7 of the Office Action is not based on a combination of references. Rather, the rejection is based on Shinsha **or** Wang **or** Kuehlmann. Also, for a rejection based on a combination of references, the Examiner must provide motivation to combine the references. The Examiner has not provided any motivation to combine the § 103 references.

CONCLUSION

It is submitted that all pending claims patentably distinguish over the prior art and are deemed to be in a condition suitable for allowance.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Finally, if there are any additional fees associated with filing of this response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Please **AMEND** the following claims:

18. (ONCE AMENDED) The method of claim [9]17, wherein said assessing the intensity of influence of an external terminal is determined as the frequency of shifting from the source or drain of a MOS semiconductor device to the gate thereof while tracing a path linking the external terminal and [a given terminal] one or more terminals of each of the plurality of partial circuits.

30. (ONCE AMENDED) The system of claim 29, wherein the intensity of influence of said external terminal is determined as the frequency of shifting from the source or drain of a MOS semiconductor device to the gate thereof while tracing a path linking the external terminal and [a given terminal] one or more terminals of each of the plurality of partial circuits.

42. (ONCE AMENDED) The apparatus of claim 41, wherein the intensity of influence of said external terminal is determined as the frequency of shifting from the source or drain of a MOS semiconductor device to the gate thereof while tracing a path linking the external terminal and [a given terminal] one or more terminals of each of the plurality of partial circuits.